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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,947

11/24/2003

Brian L. McMurray

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09/13/2007

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EXAMINER

PIZIALI, ANDREW T

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

09/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,947

Applicant(s)

MCMURRAY, BRIAN L.

Examiner

Andrew T. Piziali

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-13, 15-20 and 22-43 is/are pending in the application.
- 4a) Of the above claim(s) 3, 10, 11, 16, 18-20, 23-33 and 41-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 12, 13, 15, 17, 22 and 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment and declaration filed on 7/12/2007 have been entered.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 12, 13, 22 and 35-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 3,254,510 to Lesley.

Regarding claims 1, 5, 12, 13, 22 and 35-37, Lesley discloses a multi-directional stretch performance fabric comprising: a two-sided single layer stretch warp knit fabric comprising a first side formed by stitches of a first yarn, a second side formed by a stitch evaded portion of a second yarn, and an elastomeric or stretch yarn incorporated into the front stitches, wherein the elastomeric or stretch yarn forces the stitch evaded yarn to the second side, and wherein the fabric is integrally formed using at least two guide bars such that the first and second sides have

at least one different quality from the other side (raised nap or pile surface effect), thereby providing a multi-directional stretch performance fabric for use alone or as an article including the fabric (see entire document including column 1, lines 16-19, the paragraph bridging columns 1 and 2, column 4, lines 46-59, and column 5, lines 3-40). Lesley specifically discloses that the front and back bars may be patterned exactly as illustrated in Figures 1 and 2 of the current specification (column 5, lines 25-40). Lesley also specifically discloses that a third warp may be floated into (laid-in) the fabric for additional effects (column 4, lines 46-59).

In the event that it is shown that the applied prior art does not disclose the claimed embodiment with sufficient specificity, the invention is obvious because the prior art specifically discloses the claimed constituents.

Regarding claim 5, Lesley discloses that a two warp fabric may be constructed using two bars (column 1, lines 50-71) or a three warp fabric may be constructed (column 4, lines 46-59).

Regarding claim 12, Lesley discloses that the fabric may include a nylon or polyester fiber (column 5, lines 3-24).

Regarding claim 13, Lesley discloses that the fabric may include multifilament and/or staple fibers (column 5, lines 3-24).

Regarding claim 22, considering that only one side has a raised nap or pile surface effect (column 1, lines 16-19), the at least one different quality is provided for at least 90% quality to each side.

Regarding claim 35, Lesley discloses that the fiber components forming the fabric may have weights between 7 to several thousand denier (column 5, lines 3-24).

Claim Rejections - 35 USC § 103

5. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,254,510 to Lesley as applied to claims 1, 5, 12, 13, 22 and 35-37 above, and further in view of USPN 4,879,169 to Zafiroglu.

Regarding claim 4, Lesley discloses that a two warp fabric may be constructed using two bars (column 1, lines 50-71) or a three warp fabric may be constructed (column 4, lines 46-59).

Regarding claims 4 and 15, Lesley does not appear to specifically mention the use of spandex, but Lesley does disclose that the tighter tensioned warp yarn must be formed of elastic yarn (column 5, lines 3-24). Zafiroglu discloses that it is known in the knit fabric art to use spandex yarn as elastic material (see entire document including column 2, lines 35-43 of Zafiroglu). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the yarn from any suitable elastic material, such as spandex, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired.

6. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,254,510 to Lesley as applied to claims 1, 5, 12, 13, 22 and 35-37 above, and further in view of anyone of USPN 4,574,397 to Dennard or USPN 5,123,117 to Prendergast.

Regarding claims 6-9, Kasey does not appear to specifically disclose that the at least one different quality between fabric sides may include a color difference, but Dennard and Prendergast each disclose that it is known in the fabric art to use different colors for the two sides of a fabric so that the fabric provides different colors when reversed (see entire document including column 1, lines 18-45 of Dennard and column 1, lines 6-68 of Prendergast). It would

have been obvious to one having ordinary skill in the art at the time the invention was made to make the at least one different quality include a color and/or shade difference, because the different colors and/or shades would allow for a different color and/or shade fabric when reversed and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Regarding claims 7 and 8, Dennard and Prendergast are silent with regards to specific methods of varying the color of the fibers, therefore, it would have been obvious to look to the prior art for conventional methods. The examiner takes Official Notice that dyeing is a well-known method of changing the color of fibers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fabric sides possess different colors by dyeing the sides different colors, motivated by the expectation of successfully practicing the invention of Kasey.

Regarding claim 8, it is the examiner's position that the article taught or suggested by the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely

on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,254,510 to Lesley as applied to claims 1, 5, 12, 13, 22 and 35-40 above, and further in view of USPN 5,916,273 to Hepfinger.

Lesley does not appear to specifically mention the use of microdenier fibers, but Hepfinger discloses that it is known in the knitted fabric art to use microdenier fibers for a variety of reasons, including to enhance the feel and softness of the fabric (see entire document including column 1, lines 4-9 and column 4, lines 5-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include microdenier fibers, because microdenier fibers enhance the feel and softness of the fabric and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,254,510 to Lesley as applied to claims 1, 5, 12, 13, 22 and 35-40 above.

Lesley does not disclose a specific fabric weight, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the weight of the fabric, such as from about 4 to 12 ounces per square yard, because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art and because different fabric applications require different weights.

9. Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,254,510 to Lesley as applied to claims 1, 5, 12, 13, 22 and 35-37 above, and further in view of USPN 5,855,124 to Donaghy.

Lesley appears to be silent with regards to processing the fabric into garment/accessory, but Donaghy discloses that it is known in the warp knit fabric art to form garments/accessories (column 1, lines 6-20 and column 3, lines 16-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fabric into garment or accessory, motivated by a desire to form the fabric into marketable product.

10. Claims 1, 4, 5, 12, 13, 15, 22 and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,041,861 to Kasey in view of USPN 4,879,169 to Zafiroglu in view of USPN 3,254,510 to Lesley.

Regarding claims 1, 4, 5, 12, 13, 15, 22 and 34-40, Kasey discloses a multi-directional fabric comprising a two-sided single layer warp knit fabric comprising a first side formed by stitches of a first yarn and a second side formed by stitches of a second yarn, that are integrally formed using at least two guide bars, such that the first and second sides have at least one different quality (differential shrinkage) from the other side, thereby providing a multi-directional performance fabric for use alone or as an article including the fabric (see entire document including column 1, lines 32-44, column 2, lines 7-67, and column 3, lines 3-19).

Kasey discloses that any shrinkable yarn may be used (column 2, lines 7-36) to produce products that conventionally comprise elastic material (column 3, lines 60-64), but Kasey does not appear to specifically mention the use of spandex yarn. Zafiroglu discloses that it is known in the knit fabric art to use spandex yarn and that spandex is known to shrink (see entire

document including column 2, lines 35-43 of Zafiroglu). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the yarn from any suitable shrinkable yarn material, such as spandex, because spandex is conventionally used in products such as undergarment fabrics and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Kasey discloses that the fabric may be prepared using any standard knitting machine (column 3, lines 2-19), but Kasey does not appear to specifically mention a stitch evasion technique. Lesley discloses that it is known in the warp knitting art to construct a fabric with a stitch evasion technique (see entire document). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the knit fabric from any suitable knitting technique, such as stitch evasion, as taught by Lesley, because it is within the general skill of a worker in the art to select a known knitting technique on the basis of its suitability and desired characteristics.

The substitution of known equivalent structures involves only ordinary skill in the art. *In re Fout* 213 USPQ 532 (CCPA 1982); *In re Susi* 169 USPQ 423 (CCPA 1971); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *In re Ruff* 118 USPQ 343 (CCPA 1958). When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result. **KSR**

v. Teleflex

Regarding claims 4 and 5, Kasey discloses that three guide bars may be used (column 3, lines 3-19).

Regarding claim 12, Kasey discloses that the fabric may include fibers of polyester, cotton, or wool (column 2, lines 7-36).

Regarding claim 13, Kasey discloses that the fabric may include spun staple fibers, multifilament fibers, or combinations thereof (column 2, lines 7-10).

Regarding claim 22, Kasey discloses that the differential shrinkage yarns may provide for 100% quality unique to each side (column 2, lines 45-48).

Regarding claim 34, Kasey discloses that the fabric may have a weight of 3.37 oz/yd^2 (considered to be about 4 oz/yd^2) (see Examples).

Regarding claim 35, Kasey discloses that the fiber components forming the fabric may have a weight of 40 denier (see Examples).

Regarding claims 37-40, Kasey discloses that the fabric may be used to make an article such as slips, gowns, lingerie, dresses, blouses, and outer-wear fabrics (column 3, lines 60-64).

11. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,041,861 to Kasey in view of USPN 4,879,169 to Zafiroglu in view of USPN 3,254,510 to Lesley as applied to claims 1, 4, 5, 12, 13, 15, 22 and 34-40 above, and further in view of anyone of USPN 4,574,397 to Dennard or USPN 5,123,117 to Prendergast.

Regarding claims 6-9, Kasey does not appear to specifically disclose that the at least one different quality between fabric sides may include a color difference, but Kasey does disclose that the fabric may be used to produce outer-wear (column 3, lines 60-64). Dennard and Prendergast each disclose that it is known in the outerwear fabric art to use different colors for the two sides of a jacket fabric so that the jacket provides different colors when reversed (see entire document including column 1, lines 18-45 of Dennard and column 1, lines 6-68 of

Prendergast). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the at least one different quality include a color and/or shade difference, because the different colors and/or shades would allow for a different color and/or shade garment when reversed and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Regarding claims 7 and 8, Dennard and Prendergast are silent with regards to specific methods of varying the color of the fibers, therefore, it would have been obvious to look to the prior art for conventional methods. The examiner takes Official Notice that dyeing is a well-known method of changing the color of fibers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fabric sides possess different colors by dyeing the sides different colors, motivated by the expectation of successfully practicing the invention of Kasey.

Regarding claim 8, it is the examiner's position that the article taught or suggested by the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated

or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,041,861 to Kasey in view of USPN 4,879,169 to Zafiroglu in view of USPN 3,254,510 to Lesley as applied to claims 1, 4, 5, 12, 13, 15, 22 and 34-40 above, and further in view of USPN 5,916,273 to Hepfinger.

Kasey does not appear to specifically mention the use of microdenier fibers, but Hepfinger discloses that it is known in the knitted fabric art to use microdenier fibers for a variety of reasons, including to enhance the feel and softness of the fabric (see entire document including column 1, lines 4-9 and column 4, lines 5-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include microdenier fibers, because microdenier fibers enhance the feel and softness of the fabric and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Response to Arguments

13. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

14. Applicant's specification amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/
Primary Examiner, Art Unit 1771